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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,380	03/12/2004	Miguel Acosta	52028/RVW/A789	8844
23363	7590	07/12/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			ALI, SHUMAYA B	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	
			3743	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

**Office Action Summary**

Application No.

10/800,380

Applicant(s)

ACOSTA, MIGUEL

Examiner

Shumaya B. Ali

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>detailed action</u> .                  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, drawn to apparatus.

II. Claim 17, drawn to method

The inventions are distinct, each from the other because of the following reasons:

2. Inventions group I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case method of modifying a tracheostomy tube lacks limitations of the apparatus claim. Therefore, the method of modifying the tube can be performed without requiring all the elements of the apparatus claims.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Rodney v. Warford on 6/20/05 a provisional election was made with traverse to prosecute the invention of group I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claim 17 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Morgan US Patent 838,434.

7. **As to claim 1, Morgan discloses a fitting (fig.2 reference objects 4) for retrofitting to a tracheostomy tube comprising: an inlet portion (fig.1 reference object 11) for attachment to an outlet structure of the tracheostomy tube; and an outlet portion (a tube inherently has an inlet and outlet portion, see fig.1 reference object 4 and 11 which is capable of fitting to an outlet of any tube, including a tracheostomy tube) for extending from the outlet structure of the tracheostomy tube, wherein the outlet portion is connected to the inlet portion, and wherein the outlet portion comprises at least one side opening (page 1 lines 75-76).**

8. **As to claim 2, Morgan discloses the tracheostomy tube fitting of claim 1, wherein the outlet portion comprises a plurality of rows of side openings and a plurality of columns of side openings (see fig.1 reference object 4 has a plurality of side opening, see also page 1 lines 75-76).**

9. **As to claim 3, Morgan discloses the tracheostomy tube fitting of claim 2, wherein each row is offset from an adjacent row and wherein each column is offset from an adjacent column (clearly depicted in fig.2 reference object 4).**

Art Unit: 3743

10. **As to claim 4, Morgan discloses** the tracheostomy tube fitting of claim 1, further comprising a filter (**fig.1 reference object 7**) attached to the outlet portion for filtering air that enters the fitting through the at least one-side opening.

11. **As to claim 5, Morgan discloses** a fitting for retrofitting to a tracheostomy tube comprising: a hollow cylinder (**fig.1 reference object 4**) having an inner diameter, an outer diameter, an inlet end opening and an outlet end opening the cylinder further comprising: an inlet portion (**object 4 is considered tubular, therefore inherently has an inner and outer diameters and an inlet and outlet openings that are capable of attaching to either an inlet or outlet of any tube**), for attachment to an outlet structure of the tracheostomy tube, wherein the inlet portion comprises the inlet end opening; and an outlet portion for extending from the outlet structure of the tracheostomy tube, wherein the outlet portion is connected to the inlet portion, and wherein the outlet portion comprises the outlet end opening and at least one side opening (**page 1 lines 75-76**).that extends from the inner diameter to the outer diameter.

12. **As to claim 6, Morgan discloses** the tracheostomy tube fitting of claim wherein the outlet portion comprises a plurality of rows of side openings that extend from the inner diameter to the outer diameter and a plurality of columns of side openings that extend from the inner diameter to the outer diameter (**see fig.1 reference object 4 has a plurality of side opening, see also page 1 lines 75-76**).

13. **As to claim 7, Morgan discloses** the tracheostomy tube fitting of claim 6, wherein each row is offset from an adjacent row and wherein each column is offset from an adjacent column (**clearly depicted in fig.2 reference object 4**).

14. **As to claim 8, Morgan discloses** the tracheostomy tube fitting of claim 5, further comprising a filter (**fig.1 reference object 7**) attached to the outlet portion for filtering air that enters the fitting through the at least one-side opening.

15. **As to claim 9, Morgan discloses** a tracheostomy tube comprising: an inlet structure (**fig.1 reference object 12**) for insertion into a patient's trachea; and an outlet structure (**fig.1 reference object 4**) for extending from an opening in the patient's neck, wherein the outlet structure is connected to the inlet structure, and wherein the outlet structure comprises at least one side opening (**see fig.1 reference object 4 has a plurality of side opening, see also page 1 lines 75-76**).

16. **As to claim 10, Morgan discloses** the tracheostomy tube of claim 9, wherein the outlet structure comprises a plurality of rows of side openings and a plurality of columns of side openings (**see fig.1 reference object 4 has a plurality of side opening, see also page 1 lines 75-76**).

17. **As to claim 11, Morgan discloses** the tracheostomy tube of claim 10, wherein each row is offset from an adjacent row and wherein each column offset from an adjacent column (**clearly depicted in fig.2 reference object 4**).

18. **As to claim 12, Morgan discloses** the tracheostomy tube of claim 9, further comprising a filter (**fig.1 reference object 7**) attached to the outlet structure for filtering air that enters the tracheostomy tube through the at least one-side opening.

19. **As to claim 13, Morgan discloses** a tracheostomy tube comprising: an inlet structure (**fig.1 reference object 12**) for insertion into a patient's trachea; and an outlet structure (**fig.1 reference object 4**) for extending from an opening in the patient's neck, wherein the outlet structure is connected to the inlet structure (**page 1 lines 100-101**), and wherein the outlet structure comprises an inner diameter, an outer diameter and at least one side opening that extends from the inner diameter to the outer diameter (**object 4 is considered tubular, therefore inherently has an inner and outer diameters and an inlet and outlet openings that are capable of attaching to either an inlet or outlet of any tube**),

Art Unit: 3743

20. **As to claim 14, Morgan discloses** the tracheostomy tube of claim 13, wherein the outlet structure comprises a plurality of rows of side openings that extend from the inner diameter to the outer diameter and a plurality of columns of side openings that extend from the inner diameter the outer diameter (**see fig.1 reference object 4 has a plurality of side opening, see also page 1 lines 75-76**).

21. **As to claim 15, Morgan discloses** the tracheostomy tube claim 14, wherein each row is offset from an adjacent row and wherein each column is offset from an adjacent column (**clearly depicted in fig.2 reference object 4**).

22. **As to claim 17, Morgan discloses** the tracheostomy tube of claim 13; further comprising a filter (**fig.1 reference object 7**) attached the outlet structure for filtering air that enters the tracheostomy tube through the at least one-side opening.

### ***Conclusion***

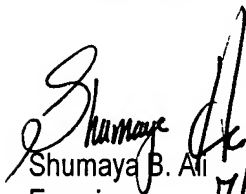
23. The prior art made of record on form PTO-892 and not relied upon: US Patent 5,840,091 discloses a filter with a plurality of side openings as a fitting for retrofitting to the outlet of a tracheostomy tube, US patent 2,491,647 discloses a tubular retaining device as a fitting for retrofitting to the outlet of a tracheostomy tube with plurality of side openings.

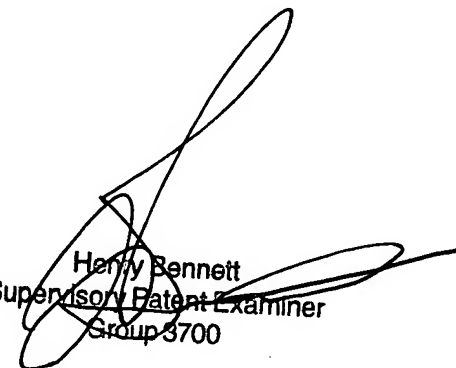
24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Shumaya B. Ali** whose telephone number is **571-272-6088**. The examiner can normally be reached on M-F 8:30 am-4: 30 pm.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Henry Bennett** can be reached on **571-272-4791**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-6088.

Art Unit: 3743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shumaya B. Ali  
Examiner  
Art Unit 3743  
7/8/05

  
Henry Bennett  
Supervisory Patent Examiner  
Group 3700